

Notice of Allowability

Application No.

10/676,715

Examiner

Taylor Victor Oh

Applicant(s)

HOPMANN ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/19/05.
2. ☒ The allowed claim(s) is/are 1-7, 9-11, renumbered as claims 1-10.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>3/6/06</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

The previous final rejection has been vacated.

The Status of Claims

Claims 1-7 and 9-11 are pending.

Claims 1-7 and 9-11 have been allowable.

Claim 8 is canceled.

Amendment to the Specification

The following paragraph will be added before the subtitle "BACKGROUND OF THE INVENTION" on the page 1 of the specification:

"Priority Data

The present application claims the benefit of the following non-provisional application filed on January 13, 2003: 60/439,629."

It is noted that the phrase " **DEAV2002/0066 US NP** "

at the top of the specification and the abstract section is to be removed ;

U.S. Application Numbers "10676715" should be inserted at the top of the specification ,
and the abstract section.

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I. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Irving Newman on 3/6/06.

II. The application has been amended as follows:

In claim 7 , lines 2-3 on page 3 (amendment filed on 12/19/05):

The phrase “ -- or one of its variants or mutants--” after “DSM 14453” has been deleted.

Claim 8 has been canceled.

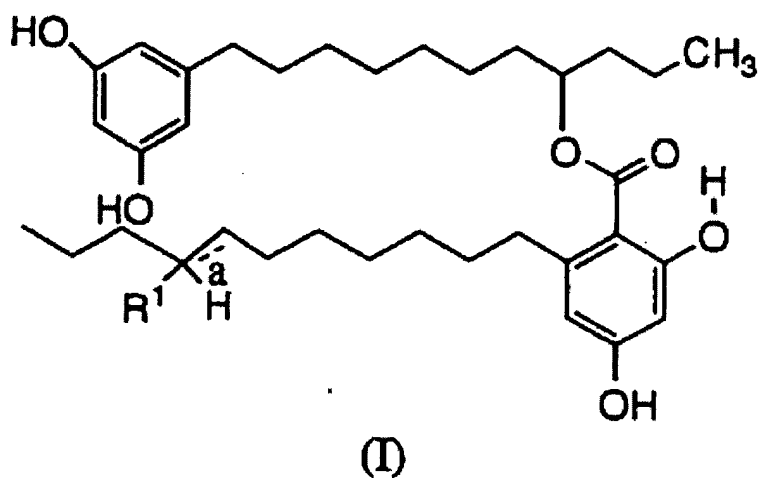
III. The following is an examiner's statement of reasons for allowance:

- The rejection of Claim 11 under 35 USC 101 has been withdrawn due to the modification of claim 11 made in the amendment.

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- The rejection of claims 4, 7, and 11 under 35 USC 112, first paragraph has been withdrawn due to the Deposit Declaration under 37 CFR 1.801 being filed on 12/19/2005.
- The rejection of claims 4 and 7 under 35 USC 112, second paragraph has been withdrawn due to the deletion of the phrase "one of its variants and/or mutants" in the claims.
- The closest prior art is Bills et al (GB 2327674 A).

Bills et al discloses the following compounds below:



when "a" represents a single bond, R¹ is selected from:

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(1) -OH, and
(2) -OC(O)-CH₃; and
when "a" represents a double bond,
R¹ is absent,
and pharmaceutically acceptable salts and esters thereof.

However, the instant invention differs from the prior art in that the claimed compounds do not have any double bond or any substituent on the long alkyl chain unlike the prior art compounds which have a OH, -OC(O)-CH₃, or a double bond ; therefore, there is no anticipation or motivation in the prior art to arrive at the current invention. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to " Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Angela Victor DZ
3/14/06